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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/685,745

10/15/2003

Lukas Eisermann

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7590

07/25/2006

HAYNES AND BOONE, LLP

901 MAIN ST

SUITE 3100

DALLAS, TX 75202

EXAMINER

PHILOGENE, PEDRO

ART UNIT

PAPER NUMBER

3733

DATE MAILED: 07/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	10/685,745		EISERMANN, LUKAS	
	<b>Examiner</b>		<b>Art Unit</b>	
	Pedro Philogene		3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 October 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 15-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>7/11/05;3/11/04</u> .   | 6) <input type="checkbox"/> Other: _____                                    |

***Election/Restrictions***

This application contains claims directed to the following patentably distinct species: FIGS. 1-5 relating to claims 1-14.

FIGS 6,7 relating to claims 15-18.

FIG. 8 relating to claims 19-22.

The species are independent or distinct because FIGS.1-5 relating to a device for a disc replacement comprising a shell, a fulcrum and a damping sleeve. FIGS 6,7 relating to a shell system comprising a first shell and a second shell that articulate with each other. FIG.8 relating to a disc replacement device comprising a shell having an opening with a pillar adapted for coupling with the shell at the opening. Therefore, each claim 1,15 or 19 is claiming a different inventive concept with the shell linking the three species. The claims of FIGS.1-5 relating to a single shell that articulates with a fulcrum, while the claims of FIGS.6, 7 relating to two shells that articulate with each other, and the claims of FIG.8 relating to a shell with an opening with a pillar (no information provided for articulation). Therefore, the species are independent and distinct.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claim is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim

is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

During a telephone conversation with David M O'Dell on 7/17/06 a provisional election was made with traverse to prosecute the invention of FIGS 1-5, claims 1-14. Affirmation of this election must be made by applicant in replying to this Office action. Claims 15-22 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4,6,8,10,13 are rejected under 35 U.S.C. 102(e) as being anticipated by Graf (2003/0055427).

With respect to claim 1, Graf discloses a disc replacement device comprising a shell, a fulcrum, and a damping sleeve, as best seen in FIG. 6, a first portion adapted for articulation with the fulcrum and a second portion adapted for coupling with the damping sleeve; as best seen in FIG.6.

With respect to claims 2-4, 6,8,10,13, Graf discloses all the limitations; as set forth in para [0017-0031] and as best seen in FIGS.4, 6.

Claims 1, 5-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Ferree et al (2003/0074076).

With respect to claim 1, Ferree et al disclose a disc replacement device comprising a shell, a fulcrum, and a damping sleeve, as best seen in FIGS. 2, 6, a first portion adapted for articulation with the fulcrum and a second portion adapted for coupling with the damping sleeve; as best seen in FIGS.2, 6.

With respect to claims 5-8, Ferree et al disclose all the limitations; as set forth in para [0029-0040] and as best seen in FIGS.2,6.

Claims 1, 2, 4,6-8,10 are rejected under 35 U.S.C. 102(e) as being anticipated by Viart et al. (6,682,562).

With respect to claim 1, Viart et al disclose a disc replacement device comprising a shell, a fulcrum, and a damping sleeve, as best seen in FIG. 2, a first portion adapted for articulation with the fulcrum and a second portion adapted for coupling with the damping sleeve; as best seen in FIG.2.

With respect to claims 2,4, 6-8,10, Viart et al disclose all the limitations; as set forth in column 3, lines 1-67, column 4, lines 1-31, and as best seen in FIGS.1-3.

Claims 1, 3, 6,8,12 are rejected under 35 U.S.C. 102(e) as being anticipated by Gauchet et al. (6,733,532).

With respect to claim 1, Gauchet et al disclose a disc replacement device comprising a shell, a fulcrum, and a damping sleeve, as best seen in FIGS. 2, 6, a first portion adapted for articulation with the fulcrum and a second portion adapted for coupling with the damping sleeve; as best seen in FIGS.2,6.

With respect to claims 3, 6,8,12, Gauchet et al disclose all the limitations; as set forth in column 3, lines 1-67, column 4, lines 1-67, column 5, lines 1-27; and as best seen in FIGS.2, 6.

Claims 1, 3, 6-8,14 are rejected under 35 U.S.C. 102(e) as being anticipated by Eberlein et al. (6,626,943).

With respect to claim 1, Eberlein et al disclose a disc replacement device comprising a shell, a fulcrum, and a damping sleeve, as best seen in FIG. 2, a first portion adapted for articulation with the fulcrum and a second portion adapted for coupling with the damping sleeve; as best seen in FIG.2.

With respect to claims 3, 6-8,14, Eberlein et al disclose all the limitations; as set forth in column 5, lines 13-67, and as best seen in FIG.2.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1,2,4,6-8,10,11 are rejected under 35 U.S.C. 102(b) as being anticipated by Hoffmann-Daimler (DE 2,263,842) (submitted by applicant).

With respect to claim 1, Hoffmann-Daimler discloses a disc replacement device comprising a shell, a fulcrum, and a damping sleeve, as best seen in FIGS. 7, 8, a first portion adapted for articulation with the fulcrum and a second portion adapted for coupling with the damping sleeve; as best seen in FIGS 7, 8.

With respect to claims 2,4, 6-8,10,11, Hoffman-Daimler discloses all the limitations; as set forth in page 2, line 2 to page 18, line 14 and as best seen in FIGS. 7-8.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Viart et al. (6,682,562) in view of Zdeblick et al. (6,402,785).

With respect to claim 9, it is noted that Viart et al did not teach of a shell comprising a shape memory alloy, as claimed by applicant. However, in a similar art, Zdeblick et al evidences the use of a shell comprising shape memory alloy to provide elastic properties substantially equivalent to the natural elastic properties of the human body.

Therefore, given the teaching of Zdeblick et al, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the memory

Art Unit: 3733

alloy in the device of Viart et al as taught by Zdeblick et al to provide elastic properties substantially equivalent to the natural elastic properties of the human body.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gauchet et al. (6,733,532) in view of Fehling et al. (6,770,094).

With respect to claim 12, it is noted that Gauchet et al did not teach of a sleeve comprising a shape memory alloy, as claimed by applicant. However, in a similar art, Fehling et al evidences the use of a sleeve comprising shape memory alloy to provide elastic properties substantially equivalent to the natural elastic properties of the human body.

Therefore, given the teaching of Fehling et al, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the memory alloy in the device of Gauchet et al as taught by Fehling et al to provide elastic properties substantially equivalent to the natural elastic properties of the human body.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

6,063,121

05-2000

Xavier et al.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pedro Philogene whose telephone number is (571) 272-4716. The examiner can normally be reached on Monday to Friday 6:30 AM to 4:00 PM.



If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272 - 4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Pedro Philogene  
July 17, 2006

  
PEDRO PHILOGENE  
PRIMARY EXAMINER